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10/786,760

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EXAMINER

CHONG CRUZ, NADJA N

ART UNIT

PAPER NUMBER

3623

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/786,760	<b>Applicant(s)</b> OLANDER ET AL.	
	<b>Examiner</b> NADJA CHONG CRUZ	<b>Art Unit</b> 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/14/2005, 2/7/2005, 2/17/2005, 2/28/2005,</u>                | 6) <input type="checkbox"/> Other: _____                          |
| <u>3/11/2005, 3/16/2005, 7/5/2006, 11/27/2006, 11/29/2006, 8/3/2007, 9/26/2007,</u>    |   |
| <u>11/28/2007.</u>   |   |



## **DETAILED ACTION**

### **Status of Claims**

1. This is a Non-Final office action in reply to the application filed on 25 February 2004.
2. Claims 1-31 are currently pending and have been examined.

### **Priority**

3. Applicant's claim for the benefit of a prior-filed application, Provisional Application No. 60/451,348, under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged.

### **Claim Rejections - 35 USC § 101**

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-8 and 25-31 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. As recited, claims 1-9 and 25-31 are directed toward control logic, software per se. However, under the current guidelines of 35 USC 101, computer software must be tangibly embodied on a computer readable medium, and, when executed by a computer processor, perform the steps of the software. In their broadest reasonable interpretation and in light of the specification, claims 1-9 and 25-31, as recited, can be interpreted to be embodied on abstract mediums such as carrier waves and signals, and therefore not eligible for patent protection. Accordingly, claims 1-9 and 25-31 are not eligible for patent protection.

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6. Further, Claims 1-8 and 25-31 are rejected under 35 U.S.C. 101 because the claimed invention lacks tangible result. The preamble of the claim states *a software framework for implementing business processes in a web application*; however the limitations of the claims does not recite elements that would constitute a physical transformation or indicate a useful, concrete and tangible result. Rather the claims merely describe a software framework for implementing business process in a portal without tangible result (e.g., a concrete solution). Claims 2-8 inherit the same deficiencies as claim 1 and are therefore rejected for the same reasons as claim 1 and claims 26-31 inherit the same deficiencies as claim 25 and are therefore rejected for the same reasons as claim 25.
7. Claims 9-16 are rejected under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).
8. An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.
9. Here, applicant's method steps, fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be performed without the use of a particular apparatus. Thus, claims 9-16 are non-statutory since they may be preformed within the human mind.

10. Nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process. See *Benson*, 409 U.S. at 71-72. As *Comiskey* recognized, "the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter." *Comiskey*, 499 F.3d at 1380 (citing *In re Grams*, 888 F.2d 835, 839-40 (Fed. Cir. 1989)). Incidental physical limitations, such as data gathering, field of use limitations, and post-solution activity are not enough to convert an abstract idea into a statutory process. In other words, nominal or token recitations of structure in a method claim do not convert an otherwise ineligible claim into an eligible one. Claims 2-18 inherit the same deficiencies as claim 1 and are therefore rejected for the same reasons as claim 1.
11. Claims 9-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 9 is directed to an abstract idea with no useful, concrete and tangible result. An abstract idea is statutory under 35 U.S.C. 101 when there is a practical application of the judicial exception indicated by the claims such as a physical transformation or a useful, concrete and tangible result. Here the remaining limitations of the claim do not recite elements that would constitute a physical transformation or indicate a useful, concrete and tangible result. Rather the claims merely describe a method for implementing business process in a portal without tangible result (e.g., a concrete solution). Because there is no practical application of the judicial exception, the claim does not meet the statutory requirements of 35 U.S.C. 101. Claims 10-16 inherit the same deficiencies as claim 9 and are therefore rejected for the same reasons as claim 9.

#### **Claim Rejections - 35 USC § 102**

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:  
  
A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 1-2, 4, 6-10, 12, 14-18, 20, 22-25, 27 and 29-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Huang et al, **Agent-based workflow management in collaborative product development on the Internet**, *Computer-Aided Design*, 32, 2000 pages 133-144, hereinafter Huang.

**Claims 1, 9 and 17:**

Huang as shown discloses a software framework and method implementing business processes in a web application, the software framework and method comprising:

- *a workflow* (page 135, 1<sup>st</sup> column, Workflow: which teaches that “a workflow describes a product development project in a network model”);
- *a control operable to invoke the workflow* (page, 135, Agents and pages 142-143, 1<sup>st</sup> column, 1<sup>st</sup> ¶ where Figure 4 illustrates control operable: input and output properties which “[s]uch flows of control between agents are used to trigger the messages defined as flows of data between agents. It is through these messages that agents share their properties to collaborate.” In addition, “agents are client-side components of Web applications” and “[a]gents form basic constructs of project workflow models.”);
- *and a page group operable to invoke the control* (Figures 3-4, Figure 3 illustrates an agent-based workflow management model, which includes Web servers for agentManager and wfManager which page group (e.g., portal web pages) operable to invoke the control (e.g., Figure 4: Agents 1, 2 and 3);

**Claims 2, 10 and 18:**

Huang teaches the following limitation:

- *a message broker operable to enable communication between the control and the workflow* (Figure 3, which it illustrates the communication between the agents and

the servers and page 135, 2.1 TeleDSS, 3<sup>rd</sup> ¶: which teaches that TeleDSS can be made accessible within Web browsers when they are developed” where “[i]n many occasions, wrappers, often called agents, also provide facilities to enable resulting systems to communicate with other applications, sending and receiving messages, files, etc.”. In order to communicate via sending and receiving messages it is taught that a message broker operates to enable communication);

**Claims 4, 12, 20 and 27:**

Huang teaches the following limitation:

- *the page group includes control logic for a graphical user interface* (Figure 4, which it illustrates graphical user interfaces with input and output properties which includes control logic);

**Claims 6, 14, 22 and 29:**

Huang teaches the following limitation:

- *the control can communicate with another control* (Figure 3, which it illustrates that agents contains controls can communicate with another agents and page 135 and 143, which teaches that “[s]uch flows of control between agents are used to trigger the messages defined as flows of data between agents. It is through these messages that agents share their properties to collaborate.” In addition, “agents are client-side components of Web applications” and “[a]gents form basic constructs of project workflow models.”)

**Claims 7, 15, 23 and 30:**

Huang teaches the following limitation:

- *a web browser; and wherein the web browser is operable to send a request to the page group* (page 138, 3.3 Agent definition, which teaches that “[t]he user uses the Web browser to connect to the Web server where agentNavigator is deployed.



Upon connection, agentNavigator is downloaded to and executed" (e.g., a request to the page group is sent) "at the client machine.");

**Claims 8, 16, 24 and 31:**

Huang teaches the following limitation:

- *the control is transactional* (page 141, 2<sup>nd</sup> column, which teaches that "[f]lows of data, or message passing, are triggered by the flow of control. For example, if Agent 1 has not finished with its work, flows of data associated with Agents 2 and 3 will not be processed" which depends on the business process);

As per **claim 25**, this claim encompasses substantially the same scope as claims 1 and 2. Accordingly, claim 25 is rejected in substantially the same manner as claims 1 and 2, as described above.

**Claim Rejections - 35 USC § 103**

- 14.** The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 15.** Claims 3, 5, 11, 13, 19, 21, 26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huang et al, **Agent-based workflow management in collaborative product development on the Internet**, *Computer-Aided Design*, 32, 2000 pages 133-144, hereinafter Huang as applied to claims 1-2, 4, 6-10, 12, 14-18, 20, 22-25, 27 and 29-31 above, and further in view of Tolkendorf, **Workspaces: A Web-Based Workflow Management System**, *IEEE Internet Computing*; 2002.

**Claims 3, 11, 19 and 26:**

Huang does not teach the following limitation. However, Tolksdorf in an analogous art of web-based workflow management system for the purpose of a workflow to invoke another workflow (e.g., sub-workflow) (Figure 1) as shown does:

- *the workflow can invoke another workflow* (page 19, Coordination, which teaches that “[t]he Workspaces engine, which features a simple GUI through which users select their next steps, interfaces with external applications and retrieves subworkflows” (e.g., invoke another workflow) “or *workflow graphs* transmitted through the network by external providers” );

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to invoke another workflow as taught by Tolksdorf, to improve Huang, thereby giving the predictable result of enabling a user through a graphical user interface to retrieve subworkflows or workflows graphs” (Tolksdorf, page 19 and Figure 1).

**Claims 5, 13, 21 and 28:**

Huang does not teach the following limitation. However, Tolksdorf in an analogous art of web-based workflow management system for the purpose of a programmatic interface (Figure 8) as shown does:

- *the control exposes functionality through a programmatic interface* (Figure 8, which it illustrates a Workspaces engine user interface where through this interface, the engine presents the user with a selectable list of steps and page 21, Workflow Graphs, which teaches that “[w]orkspaces also provides a tool called Floweditor, which includes a graphical interface that can model such workflows and automatically generate the corresponding WSCL representation”);

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use a programmatic interface as taught by Tolksdorf, to improve Huang, thereby giving the predictable result of enabling a user to “model such workflows” and to “automatically generate the corresponding WSCL representation” (Tolksdorf, page 21).

### Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
- Van Run et al (WO 01/59586) disclose a work-flow system for web-based application.
  - Sitka (US 6,330,572 B1) discloses a hierarchical data storage management.
  - Dhar et al (US 2002/0040312 A1) disclose an object based workflow system and method.
  - Hoffman et al (US 2002/0147606 A1) disclose an application development method.
  - Poulter et al (US 6,618,730 B1) disclose a methods and systems for managing workflow.
  - McDonough et al (US 2004/0049345 A1) disclose distributed, collaborative workflow management software.
  - Ames et al, **Applications of Web-Based Workflow**, California Institute of Technology, IEEE, 1998 which disclose a web-based workflow system.
  - Gould, **Designing a better business**, *Automotive Manufacturing & Production*. Aug 2000. Vol. 112, Iss. 8; pg. 62, 4 pgs, which disclose flowcharting and enterprise simulation tools for workflows.
  - Fontana, **ERoom adds workflow to collaboration software**, *Network World*. Framingham: Feb 25, 2002. Vol. 19, Iss. 8; pg. 25, 2 pgs, which disclose the integration of collaboration tools into enterprise applications.
  - Von Uthmann et al, **Internet technology to run workflows**, *Internet Research*. Bradford: 1998. Vol. 8, Iss. 5; pg. 414, which disclose INTERFYS as an innovative Internet-based system concept for making processes more efficient by applying the concepts of workflow management using Web technologies only.

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- Hayes et al, **Workflow Interoperability Standards for the Internet**, IEEE Internet Computing, 2000, which disclose standards for internet-based workflows.
- Tauhert, **Web-ifying workflow**, *Insurance & Technology*. New York: Jul 1998. Vol. 23, Iss. 7; pg. 30, 5 pgs, which disclose web-enabling workflows.
- Rhodes Jr., **Workflow completes equation, AS/400 Systems Management**. Arlington Heights: Dec 1998. Vol. 26, Iss. 12; pg. 28, 3 pgs, which disclose a workflow solution that allows AS/4000-based businesses to define and manage electronic work processes through the World Wide Web.
- Bolcer et al, **SWAP: leveraging the Web to manage workflow**, *Internet Computing, IEEE*, Jan/Feb 1999, which disclose workflow browser-based user interfaces.

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Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Nadja Chong** whose telephone number is **571.270.3939**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **BETH BOSWELL** can be reached at **571.272.6737**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

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or faxed to **571-273-8300**.

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/Nadja Chong/ Examiner, Art Unit 3623

/Scott L Jarrett/

Primary Examiner, Art Unit 3623